

Amendment After Final Rejection
U.S. Patent Application Serial No. 10/723,692
Office Action Dated: November 30, 2007
Inventor: James B. McCormick
Attorney Docket No. 46521-56177

REMARKS

This Amendment is filed in response to the Office Action dated November 30, 2007. There was a voice mail left on January 2, 2008 for Examiner Ramillano suggesting the proposed limitation of "fluid permeability." Examiner Ramillano responded by suggesting that the proposed limitation of "fluid permeability" should be included in a formal Amendment After Final Rejection rather than an Examiner's Amendment.

Rejection Under 35 U.S.C. § 102(b):

Claim 1 was rejected under 35 U.S.C. § 102(b) as being unpatentable over Dyke (U.S. Patent No. 4,874,090). These claims are specifically amended to refer to a fluid permeable sheet and fluid permeable target. Support for this amendment can be found on Page 4, Paragraph [0018], Lines 3-8 as follows: "Because permeable, filter-type papers come in a wide range of permeability, thickness, and strengths, many types of papers will work as permeable sheet 12 as long as the sheet is **porous to the typical processing fluids** used in histological preparation in an efficient manner according to routine histological procedures while retaining tissue specimens 1 mm or smaller in size." (Emphasis added). Also, support for this amendment can be found on Page 5, Paragraph [0022], Lines 6-8 as follows: "However, other arrangements of holes and porosities that may allow for the **passage of fluids** and retention of samples will also

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work for target 14 when constructed out of perforated stainless steel.” (Emphasis added). Therefore, no new matter has been added.

Dyke requires: “A sterilizable pouch comprising: a first sheet-like member made of a material which is **impermeable to microorganisms** and a second sheet-like member, opposing said first member, made of a material which is **impermeable to microorganisms,...**” (Claim 1, Column 4, Lines 5-9) (emphasis added). **It is respectfully believed that a surface that is impermeable to microorganisms would not be permeable to fluids.** Under 35 U.S.C. § 102, “the identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Moreover, when evaluating a claim for either anticipation or obviousness, all claim limitations must be considered. *In re Evanega*, 829 F.2d 1110, 4 U.S.P.Q. 2d 1249 (Fed. Cir. 1987).

Moreover, proper application of a reference against a device described and claimed in a patent application requires broadly that the anticipatory device be substantially the same as the anticipated device in function, structure and result. In

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this case, a sheet and target that are both fluid permeable does not have the same function, structure and result as a sheet that is impermeable to microorganisms.

Therefore, it is respectfully believed that Claim 1 overcomes the rejection under 35 U.S.C. § 102(b) and is patentable over Dyke and is in condition for allowance.

Claims 2, 5-7 depend from independent Claim 1, which are respectfully believed to overcome the 35 U.S.C. § 102(b) rejection over Dyke in the same manner as Claim 1 as described above. If an independent claim is not anticipated, then any claim depending therefrom is also not anticipated. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Claims 2, 5-7 are also amended to refer to both a fluid permeable sheet and a fluid permeable target.

Therefore, it is respectfully believed that Claims 2, 5-7 overcome the rejection under 35 U.S.C. § 102(b) and are patentable over Dyke and are in condition for allowance.

Rejection Under 35 U.S.C. § 103(a):

Claims 3 and 4 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dyke (U.S. Patent No. 4,874,090) in view of Rochette (U.S. Patent No. 3,537,636). Rochette refers to: "...a sheet of cellulose film." (Column 1, Lines 64-65). It is believed that this material is also known as cellophane. This material is liquid impermeable. It is respectfully believed to be axiomatic that the combination of two

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references that disclose liquid impermeability cannot create a liquid permeable sheet by combination of these two references.

Moreover, there is no teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385 (U.S. 2007). In determining obviousness, the proper analysis is whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts. "To reject a claim based on this rationale, U.S. Patent Office personnel must resolve the Graham factual inquiries. Office personnel must then articulate the following: (1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference; (2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely would have performed the same function as it did separately." (Federal Register / Volume 72, No. 195 / Wednesday, October 10, 2007 / Notices, Page 57529, "Examination Guidelines for Determining Obviousness Under 35 U.S.C. § 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*"). In this case, both Dyke and Rochette function in a totally different manner with fluid impermeability than as

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disclosed in the Applicant's claimed Invention specifically reciting fluid permeability and the mere combination of Dyke and Rochette would absolutely not be sufficient.

Therefore, it is respectfully believed that a proper rejection under 35 U.S.C. § 103(a), based on the United States Patent Office's own guidelines, cannot be made.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Kahn*, 441 F.3d 977, 986, 78 U.S.P.Q.2d 1329, 1335 (Fed. Cir. 2006).

Claims 3 and 4 depend from independent Claim 1, which are respectfully believed to overcome the 35 U.S.C. § 102(b) rejection over Dyke in the same manner as Claim 1 as described above. If an independent claim is not anticipated or obvious, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Therefore, Claims 3 and 4 overcome the rejection under 35 U.S.C. § 103(a) and are in condition for allowance.

Therefore, Applicant respectfully requests favorable consideration and allowance of this patent application, as currently amended. It is respectfully believed that this Amendment is proper and should be entered under 37 C.F.R. § 1.116, since it does comply with the arguments that were first raised by the Examiner in the latest Office

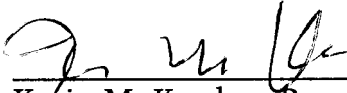
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Action and clearly overcomes the prior art. In addition, it places the claims in better condition for appeal. A new patent search should not be warranted.

Therefore, it is now believed that all of the pending Claims in the present application are in condition for allowance. Favorable action and allowance of the Claims is therefore respectfully requested. If any issue regarding allowability of any of the pending Claims in the present application could be readily resolved, or if other action could be taken to further advance this application such as an Examiner's Amendment, or if the Examiner should have any questions regarding the present Amendment, it is respectfully requested that the Examiner please telephone the Applicant's undersigned attorney in this regard.

Respectfully submitted,

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